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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/461,265	12/15/1999	NEIL MASON	CS1061#SP	3583

7590

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EXAMINER
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GOODMAN, CHARLES

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 11/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/461,265

Applicant(s)

MASON, NEIL

Examiner

Charles Goodman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15-19 is/are allowed.
- 6) ☒ Claim(s) 1-11, 13 and 14 is/are rejected.
- 7) ☒ Claim(s) 12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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DETAILED ACTION

1. The Amendment filed on August 11, 2003 has been entered.

*Continued Examination Under 37 CFR 1.114*

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 11, 2003 has been entered.

*Claim Rejections - 35 USC § 103*

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1-3, 8-11, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vannuvel (BE 440,688) in view of Grant et al.

Vannuvel discloses the invention substantially as claimed except that Vannuvel is silent on coupling of the saw to a motor. However, Grant et al teaches that it is old and well known in the art to provide the shaft with the ability to be coupled to a motor at multiple orientations as shown in Figs. 1-8, shaft (33) having one end for coupling to a motor and the other end including a retaining member for the saw blade (40). Thus, it would have been obvious to the ordinary

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artisan at the time the invention was made to provide the device of Vannuvel with the ability to couple the shaft to a motor as suggested by Grant et al in order to facilitate motor operated sawing, since it has been held that broadly providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192.

Regarding claim 9, the modified device of Vannuvel discloses the invention substantially as claimed except that it does not appear that Vannuvel, modified, includes a plurality of pairs of arms. However, it would have been obvious to the ordinary artisan at the time of the instant invention to provide the modified device of Vannuvel with a plurality of arms to facilitate additional positioning means for saw blades of various lengths, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

3. Claims 1-11, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huang in view of Grant et al.

Huang discloses the invention substantially as claimed except that Huang is silent on coupling of the saw to a motor. However, Grant et al teaches that it is old and well known in the art to provide the shaft with the ability to be coupled to a motor at multiple orientations as shown in Figs. 1-8, shaft (33) having one end for coupling to a motor and the other end including a retaining member for the saw blade (40). Thus, it would have been obvious to the ordinary artisan at the time the invention was made to provide the device of Huang with the ability to

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couple the shaft to a motor as suggested by Grant et al in order to facilitate motor operated sawing, since it has been held that broadly providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192.

Regarding claim 9, the modified device of Huang discloses the invention substantially as claimed except for a plurality of pairs of arms. However, it would have been obvious to the ordinary artisan at the time of the instant invention to provide the modified device of Huang with a plurality of arms to facilitate reinforced mounting of the saw blade, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

#### ***Allowable Subject Matter***

4. Claims 15-19 are allowed.
5. Claim 12 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Response to Arguments***

6. Applicant's arguments filed August 11, 2003 have been fully considered but they are not persuasive.

In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that obviousness can only be

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established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the suggestion stem from both references. Both Vannuvel and Grant et al teach saw blades which may be mounted on the reciprocating member in a number of orientations. The fact that Grant et al facilitates powered reciprocation of the saw blade would seem to suggest to one of ordinary skill in the art that the power operation of the saw would be advantageous over simple manual operation of the variously oriented saw blade. Thus, it is the Examiner's opinion that the combination is suggested by the prior art as noted in the rejection. Substantially the same applies to Applicant's arguments with respect to Huang in view of Grant et al.

It is also noted that whether Vannuvel or Huang use wing nuts or a knob, respectively, for locking the blade into the various positions is of no moment with respect to the rejected claims to the extent that how one of ordinary skill in the art would bodily incorporate the combined teachings of the references is not dispositive of the obviousness of the claims. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of

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ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

### ***Conclusion***


7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Goodman whose telephone number is (703) 308-0501. The examiner can normally be reached on Monday-Thursday between 7:30 AM to 6:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap, can be reached on (703) 308-1082.

In lieu of mailing, it is encouraged that all formal responses be faxed to (703) 872-9306. Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is (703) 308-1148.

cg

November 3, 2003

  
Charles Goodman  
Primary Examiner  
AU 3724

CHARLES GOODMAN  
PRIMARY EXAMINER